

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RUSSELL E. PARKS, FRANK DAVIDE,  
ALLISON M. MCCORMACK and JAE K. PARK

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Appeal No. 2004-0344  
Application No. 09/759,016

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ON BRIEF

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Before KRASS, FLEMING and DIXON, Administrative Patent Judges.  
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-7.

The invention is directed to a skills matching application (SMA) which allows a user to communicate requirements to technical service suppliers so as to procure technical services from contractors. This Web-based skills matching application is

Appeal No. 2004-0344  
Application No. 09/759,016

said to facilitate the procurement process for technical services contractors.

Representative independent claim 1 is reproduced as follows:

1. A Skills Matching Application (SMA) which allows a user to communicate requirements to technical service suppliers in a way that significantly reduces the process time and improves the accuracy of requests sent to suppliers comprising:

means for accessing the SMA from a Requisition/Catalog (REQ/CAT) application;

means for prompting a user through a series of screens to enter a Statement of Work (SOW) and complete a skills detail checklist for each of the technical skills requested;

means for submitting the request to contracted suppliers by e-mail notification notifying the supplier that a new request has been entered into the SMA application for them to review and submit a candidate against;

means for receiving from a supplier a candidate or candidates with appended resumes as appropriate; and

means for displaying for the user the supplier responses and associated resumes.

The examiner relies on the following reference:

|                      |           |                      |
|----------------------|-----------|----------------------|
| Puram et al. (Puram) | 6,289,340 | Sep. 11, 2001        |
|                      |           | (filed Aug. 3, 1999) |

Claims 1-7 stand rejected under 35 U.S.C. § 101 as lacking utility, and under 35 U.S.C. § 112, first paragraph, as not being enabled because of the lack of utility.

Appeal No. 2004-0344  
Application No. 09/759,016

Claims 1-7 stand further rejected under 35 U.S.C. § 102(e) as anticipated by Puram.

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

\_\_\_\_With regard to the rejection under 35 U.S.C. § 101, it is the examiner's position that the instant claimed invention fails to produce a "useful, concrete and tangible result" and, thus, has no practical application. In particular, the examiner alleges that the invention is not "useful" since the asserted utility is not accomplished; it is not "tangible" because it is no more than a manipulation of an abstract idea; and it is not "concrete" because the result cannot be assured.

We disagree.

The claimed invention is certainly useful in matching the skills wanted by a user with the skills of technicians employed by a supplier. The invention clearly has a tangible result because the user is given a choice of candidates from the supplier from which to choose. The invention produces a concrete result because a list, or choice, of candidates is provided to the user. Of course, the specific result will vary with the user because each user may be looking for different skills in a

technician but this does not mean that a result "cannot be assured," or that no "concrete" result is obtained, as alleged by the examiner.

Utility is a question of fact. The claims must first be interpreted to define the invention that is alleged to be useful. Stiftung v. Renishaw PLC, 945 F.2d 1173, 20 USPQ2d 1094 (Fed. Cir. 1991). While utility does not require commercial marketability Barmag Barmer Masch. AG v. Murata Mach., Ltd, 731 F.2d 831, 221USPQ561 (Fed. Cir. 1984), commercial success may demonstrate utility, Raytheon Co. v. Roper Corp., 724 F.2d 951, 220 USPQ 592 (Fed. Cir. 1983).

Appellants assert commercial success in the declaration of Russell E. Parks, June 4, 2003 and the examiner offers no counter arguments even though such commercial success may be an indicator of utility.

While the examiner appears to backtrack on his assertion of no tangible or useful result (see page 8 of the answer), the examiner still asserts no "concrete" results are produced by the instant claimed invention. In our view, the concrete result would be the display of supplier responses and associated resumes of skilled candidates matching the request of the user.

Appeal No. 2004-0344  
Application No. 09/759,016

It is our view that the claimed invention is a useful process/system for matching requested skills of candidates by the user to the skills of candidates from suppliers.

Accordingly, we will not sustain the rejection of claims 1-7 under 35 U.S.C. § 101 for lack of utility.

We also will not sustain the rejection of claims 1-7 under 35 U.S.C. § 112, first paragraph, based on lack of enablement because this rejection is premised on the lack of utility asserted in the rejection under 35 U.S.C. § 101. Clearly, based on the specification and the drawings, the skilled artisan would have been taught how to make and use the instant claimed invention without undue experimentation.

Finally, we turn to the rejection of claims 1-7 under 35 U.S.C. § 102(e) as anticipated by Puram.

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

We make reference to the answer, at pages 6-8, for the examiner's rationale in applying Puram to the instant claims.

While appellants admit that Puram describes a system wherein technical service providers enter data about their skills and users of these skills enter requirements and the system attempts to make a match, appellants allege that this is "unlike the claimed invention where suppliers respond to a Request for Service (RFS) by submitting candidates to the requester" (brief-page 19) so that whereas Puram includes a database of prospective candidates, the claimed invention includes no such database. Appellants also argue that the claimed invention is a "proprietary system" so that the suppliers of the services have contracts with the user of the system "which specify pre-negotiated rates for the services" (brief-page 19).

The arguments re "pre-negotiated rates" in a "proprietary system" and no "database" are not persuasive as they are not directed to any claimed subject matter.

We are convinced, however, by appellants' argument regarding suppliers responding to a request by submitting candidates to the requester. Each of the independent claims 1, 4 and 5, requires submitting a request to contracted suppliers by e-mail notification notifying the supplier that a new request has been entered into the SMA application for them to review and submit a candidate against. The examiner alleges that this is shown in

Appeal No. 2004-0344  
Application No. 09/759,016

Puram at column 2, lines 49-50 and 59-66, and column 3, lines 25-39. However, our review of these portions of Puram does not find such a teaching. While these portions of Puram describe interfaces that are accessible to users through the internet browser, there is no indication that users submit a request to contracted suppliers "by e-mail." Moreover, the cited portions of Puram fails to describe any notification to the supplier that a new request has been entered for the supplier to review. Rather, Puram appears merely to compare and match skills input by candidates with skills desired by a user and that the operations may be performed via the internet.

It may very well be that, in view of the disclosure of Puram, and of the similarity between Puram and the instant claimed invention, that it would have been obvious for the user to submit a request for a skilled candidate directly to a supplier via e-mail, rather than match candidates having certain desired skills with a database of candidates via the internet. However, the rejection before us is one of anticipation under 35 U.S.C. § 102(e), and not one of obviousness under 35 U.S.C. § 103. As such, we cannot sustain the rejection of claims 1-7 under 35 U.S.C. § 102(e) because the examiner has not shown that the four corners of the Puram document describe every element of

Appeal No. 2004-0344  
Application No. 09/759,016

the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. In applying a rejection under 35 U.S.C. § 102(e), the examiner must show how each and every claim element is taught in the reference and the examiner, in the instant case, has not done so.

Therefore, we will not sustain the rejection of claims 1-7 under 35 U.S.C. § 102(e).

The examiner's decision rejecting claims 1-7 under 35 U.S.C. §§ 101, 112 and 102(e) is reversed.

REVERSED

|                             |   |                 |
|-----------------------------|---|-----------------|
| ERROL A. KRASS              | ) |                 |
| Administrative Patent Judge | ) |                 |
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| MICHAEL R. FLEMING          | ) | BOARD OF PATENT |
| Administrative Patent Judge | ) | APPEALS AND     |
|                             | ) | INTERFERENCES   |
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|                             | ) |                 |
| JOSEPH L. DIXON             | ) |                 |
| Administrative Patent Judge | ) |                 |



Appeal No. 2004-0344  
Application No. 09/759,016

EK/RWK

WHITHAM, CURTIS & CHRISTOFFERSON, P.C.  
11491 SUNSET HILLS ROAD  
SUITE 340  
RESTON, VA 20190